

REMARKS

Introduction

Claims 1, 3, 4, 7-30 and 32-42 are pending in the application. In view of at least the above amendments and the following remarks, applicants request reconsideration and withdrawal of the rejections set forth in the Office Action and allowance of the pending claims.

Interview Summary

Applicants wish to thank Examiner Ebersman for the courtesy of a telephone interview conducted on August 19, 2009. Participating on behalf of the applicants were the undersigned representative and Michael Dukes (Reg. No. 59,878). During the interview, the participants discussed the rejections under 35 U.S.C. § 103 based on the cited references and the instances of Official Notice cited in the Office Action. While no agreement was reached during the interview, applicants have attempted herein to address the issues raised in the interview.

Claim Rejections under 35 U.S.C. §103(a)

The Patent and Trademark Office updated the MPEP in light of the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), to include guidelines for determining obviousness under §103(a) ("Guidelines"). As noted in the Guidelines, the four factual inquiries used in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), should be followed when considering obviousness under §103(a), including:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the prior art and the claims at issue;

- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

See MPEP § 2141(II). Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. See MPEP § 2141.

As noted in MPEP § 706.02(j) (entitled "Contents of a 35 U.S.C. 103 Rejection"):

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

Also, as stated in MPEP § 2142, entitled "Legal Concept of Prima Facie Obviousness":

The legal concept of prima facie obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. . . The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

....

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination

whether the claimed invention "as a whole" would have been obvious at that time to that person.

In addition, as noted in MPEP § 2143.01 (entitled, "Suggestion or Motivation To Modify the References"):

IV. MERE STATEMENT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS - A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE - If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE - If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Office bears the initial burden of factually supporting any rejection based on obviousness. If the Office does not establish a *prima facie* case, then the applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

For at least the following reasons, applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness against the pending claims, as amended, because the cited references and Official Notice, either individually or collectively, fail to teach, disclose or suggest each and every element recited in the amended claims.

Claims 1, 3, 4, 8-10, 15, 29, 36-37 and 39 stand rejected under 35 U.S.C. § 103(a) as obvious over Lewis (U.S. Pub. No. 2002/0065752) in view of Akifuji (U.S. Pat. No. 6,853,974). Claim 1 has been amended to include the subject matter of Claim 31.

Applicants submit that none of the cited references, either individually or in combination, teach, disclose or suggest a method for managing corporate action information of at least one entity comprising, in part, associating an associated offer category with at least a portion of the corporate action data, wherein the associated offer requires surrender of said security, as recited in Claim 1. The Office Action fails to cite any portion of Lewis or Akifuji that teaches, discloses or suggests associating an associated offer category with at least a portion of the corporate action data, wherein the associated offer requires surrender of the security. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 1.

Applicants submit that none of the cited references, either individually or collectively, teach, disclose or suggest all of the elements of Claims 3, 4, 8-10, 15, 26-29, 36-37 and 39, respectively, for at least the reasons stated above with respect to Claim 1. See MPEP §

2143.03. Accordingly, applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claims 3, 4, 8-10, 15, 26-29, 36-37 and 39.

Claims 13, 14, 16, 17, 19-22, 30-33, and 38 stand rejected under 35 U.S.C. § 103(a) as obvious over a proposed combination of Lewis, Akifuji, and Official Notice taken by the Examiner. For purposes of all Official Notice instances arising during prosecution of the present application, applicants would like to direct attention to §2144.03 of the MPEP (entitled "Reliance on Common Knowledge in the Art or 'Well Known' Prior Art"), which states:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known . . . the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), in turn citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

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C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.

Applicants respectfully submit that the thirteen (13) instances of Official Notice cited in the Office Action are improper because the facts beyond the record are not well-known or so

common knowledge in the art to be capable of instant and unquestionable demonstration as being well-known.

Applicants respectfully submit that the cited references and Official Notice, either individually or collectively, fail to teach or suggest all of the elements as required by dependent Claims 13, 14, 16, 17, 19-22, 30-33, and 38 for at least the reasons stated above regarding Claim

1. See MPEP § 2143.03. Specifically, applicants submit that the combination of elements recited in each of Claims 13, 14, 16, 17, 19-22, 30-33, and 38, which depend directly or indirectly from Claim 1, are not properly rejected under the Official Notice doctrine. The amendment to Claim 1 in combination with the elements recited in each of Claims 13, 14, 16, 17, 19-22, 30-33, and 38 create subject matter that is not well-known or so common knowledge in the art to be capable of instant and unquestionable demonstration as being well-known.

Accordingly, applicants request: (i) production of an appropriate reference or declaration corresponding to each use of Official Notice in the Office Action, or (ii) withdrawal of the obviousness rejection with respect to Claims 13, 14, 16, 17, 19-22, 30-33, and 38.

Furthermore, applicants would like to direct attention to the response submitted on December 23, 2008, wherein it is noted (emphasis added):

Applicants respectfully submit that the dependent claims currently pending in the Subject Application are allowable at least by virtue of their dependency from allowable independent claims. Applicants reserve the right, however, to make supplemental arguments as may be necessary, because the dependent claims of the Subject Application include additional features that further distinguish the claims from the cited references. A detailed discussion of these distinctions is believed to be unnecessary at this time in view of the fundamental distinctions already set forth in the above remarks.

The Office Action states that “the applicant attorney has not challenged the official notice taken in regards to Claims 13, 14, 16, 17, 19, 20, 21, 22 and as such, these instances of official notice shall for the purposes of this application be considered admitted prior art.” Office Action, p. 27. In view of the above remarks, applicants submit that the Official Notice asserted in the previous Office Action was adequately traversed by the response submitted on December 23, 2008.

Applicants submit that the amendments to Claims 1, 14, 16, 19, 21, 22 render the rejections of Claims 13, 14, 16, 17, 19-22, 30-33, and 38 moot. Accordingly, withdrawal of these rejections is respectfully requested.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as obvious over Lewis and Akifuji in view of Zangari (U.S. Pub. No. 2002/0184133). Applicants submit that the cited references, either individually or collectively, fail to teach or suggest all of the elements as required by dependent Claim 7 for at least the reasons stated above regarding Claim 1. See MPEP § 2143.03. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 7.

The proposed combination of Lewis, Akifuji and Zangari fails to teach, disclose or suggest a method for managing corporate action information of at least one entity comprising, in part, generating a list of action items associated with said corporate action data as recited in Claim 7. The examiner characterizes Zangari as teaching “a corporate action processing module that generates a list of action items associated with the corporate action (page 5, paragraphs 0056-0057).” Office Action, p. 14. Zangari states (at paras. [0056] to [0057] - emphasis added):

The data files are processed to extract information about various corporate actions and this information is used to update appropriate reference tables containing data related to information about the various securities and which are used when evaluating a portfolio.... Preferably, an automated system is provided to process the corporate input data to extract these corporate actions and update the appropriate internal data.

Zangari appears to teach updating reference tables and updating internal data. In contrast, an example of an action item is provided in paragraph [0067] of the application, where it is noted that “The category ‘Over-Committed’ is provided for all active and completed voluntary announcements that have at least one position that is less than the total response value for that position. The user 8 can clear these action items by correcting the response value to match the reported position amount.” (emphasis added). Applicants submit that Zangari does not teach, disclose or suggest generating a list of action items associated with corporate action data as recited in Claim 7. The Office Action fails to indicate any portion of the cited references that cures this deficiency. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 7.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as obvious over a proposed four-way combination of Lewis, Akifuji, Lupien (U.S. Pat. No. 5,101,353), and Official Notice. Applicants submit that the cited references, either individually or collectively, fail to teach, disclose or suggest all of the elements as required by dependent Claim 12 for at least the reasons stated above regarding Claim 1. See MPEP § 2143.03. Accordingly, applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to Claim 12.

Applicants submit that the proposed combination of Lewis, Akifuji, Lupien, and

Official Notice fails to teach, disclose or suggest a method for managing corporate action information of at least one entity comprising, in part, grouping at least a portion of data included within the end-of-the-day report by a designation selected from the group consisting of a user name, a category, an action type, a CASPR ID, a CUSIP, and a CUSIP description as recited in Claim 12. The Office Action characterizes Lewis and Lupien as failing to “expressly disclose grouping at least a portion of data included within said end-of-the-day report by a designation selected from the group consisting of a user name, a category, and an action type.” Office Action, p. 15. The Examiner took Official Notice that “it is old and well known in the art to group data on an end-of-the day report.” *Id.* Applicants submit that Lewis and Lupien fail to teach, disclose or suggest grouping at least a portion of data included within the end-of-the-day report by a designation selected from the group consisting of a user name, a category, an action type, a CASPR ID, a CUSIP, and a CUSIP description as recited in Claim 12. Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 12.

Claims 23-24 stand rejected under 35 U.S.C. § 103(a) as obvious over a proposed combination of Lewis, Akifuji, and Gregov (U.S. Pat. No. 7,376,588). Applicants submit that the cited references, either individually or collectively, fail to teach, disclose or suggest all of the elements of dependent Claim 23 for at least the reasons stated above regarding Claim 1. See MPEP § 2143.03. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 23.

Applicants submit that the combination of Lewis, Akifuji, and Gregov fails to teach, disclose or suggest a method for managing corporate action information of at least one

entity comprising, in part, associating a new announcement category with at least a portion of said corporate action data for which said notification has not been sent, as recited in Claim 23.

The Examiner characterizes Gregov as teaching “personalized promotion of new content where information about new announcements is displayed to the user (col. 7, lines 46-50).” Office

Action, p. 16. At Claims 1 and 23, Gregov recites:

1. A method in a computing system for displaying to an identified user information about new products among an inventory of products, each product of the inventory having an availability date on which the product is first available for purchase, comprising: automatically defining a range of dates, such that products whose availability dates fall within the range qualify as new products; subsetting the inventory of products to those products having an availability date on which the product is first available for purchase falling within the defined date range; from among the subsetting inventory, automatically selecting products for display based upon predicted level of interest to the user; and adding information about the selected products to a display.

23. The method of claim 1 wherein the subsetting, selecting, and adding are also performed with respect to announcements among a supply of announcements, such that information about new announcements is displayed to the user.

Gregov, col. 6, lines 30-46 and col. 7, lines 46-50. Applicants submit that these portions of Gregov fail to teach, disclose or suggest associating a new announcement category with at least a portion of the corporate action data for which the notification has not been sent, as recited in Claim 23 of the present application. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 23. Also, the cited references, either individually or collectively, fail to teach, disclose or suggest all of the elements of Claim 24 for at least the reasons stated above regarding Claim 23. See MPEP § 2143.03.

Claims 41 and 42 stand rejected under 35 U.S.C. § 103(a) as obvious over a

proposed combination of Lewis, Akifuji, and Knapp (U.S. Pub. No. 2003/10078794).

Applicants submit that none of the cited references, either individually or collectively, teach, disclose or suggest a system for managing corporate action information including at least one software module configured for associating an associated offer category with at least a portion of the corporate action data, wherein the associated offer requires surrender of the security, as recited in Claim 41. The Office Action fails to cite any portion of Lewis or Akifuji that teaches or suggests associating an associated offer category with at least a portion of corporate action data, wherein the associated offer requires surrender of said security, and Knapp fails to cure this deficiency. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 41.

Applicants further submit that none of the cited references, either individually or collectively, teach or suggest a computer-readable data storage device including instructions for associating an associated offer category with at least a portion of said corporate action data, wherein said associated offer requires surrender of said security, as recited in Claim 42. The Office Action fails to cite any portion of Lewis or Akifuji that teaches or suggests associating an associated offer category with at least a portion of said corporate action data, wherein said associated offer requires surrender of said security, and Knapp fails to cure this deficiency. Accordingly, applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claim 42.

Claims 11, 18, 25, 34-35, and 40 stand rejected under 35 U.S.C. § 103(a) as obvious over various cited references and Official Notice. Applicants traverse each of these rejections for at least the reasons set forth herein. Applicants submit that the cited references or

Official Notice, either individually or collectively, fail to teach or suggest all of the elements as required by Claims 11, 18, 25, 34-35, and 40 for at least the reasons stated above. See MPEP § 2143.03. Accordingly, applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to Claims 11, 18, 25, 34-35, and 40.

With specific regard to rejections based on taking Official Notice, applicants submit that the combination of elements recited in each of Claims 11, 18, 25, 34-35, and 40, which depend directly or indirectly from Claim 1, are not properly rejected under the Official Notice doctrine. The amendment to Claim 1 in combination with the elements recited in each of Claims 11, 18, 25, 34-35, and 40 create subject matter that is not well-known or so common knowledge in the art to be capable of instant and unquestionable demonstration as being well-known. Accordingly, applicants request: (i) production of an appropriate reference or declaration corresponding to each use of Official Notice in the Office Action, or (ii) withdrawal of the obviousness rejection with respect to these claims.

Reservation of Arguments

Applicants do not concede the correctness of the Office Action rejections with respect to any of the independent or dependent claims. Applicants reserve the right to make additional or supplemental arguments as may be necessary because the independent and dependent claims include additional features that further distinguish the claims from the cited references. A detailed discussion of these differences is unnecessary at this stage in view of the fundamental distinctions pointed out above. Applicants do not acquiesce to any of the specific rejections, assertions, and statements presented in the Office Action that have not been explicitly

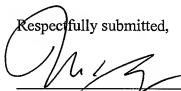
addressed herein. Applicants reserve the right to specifically address all such rejections, assertions, and statements in continuing applications, subsequent responses, and in appeal or pre-appeal proceedings.

Amendments made herein are made without prejudice or disclaimer to the subject matter of the claims as originally filed. Furthermore, applicants do not acquiesce or otherwise concede the correctness of the rejections to the previously presented claims. Accordingly, applicants hereby reserve the right to pursue the subject matter of the claims as previously presented or as originally filed in the application in related applications that may be currently on file or filed at a later date. Moreover, applicants hereby reserve the right to submit in such related applications arguments made in connection with the application. These amendments are solely made to expedite the prosecution of the application.

CONCLUSION

Applicants request reconsideration of the Office Action rejections and allowance of the pending claims of the application. To expedite prosecution of the application, any questions regarding the present response are invited to the attention of the undersigned representative.

Respectfully submitted,



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